

REMARKS/ARGUMENTS

By this Amendment, claims 1, 5, 14, 18, 27-29 and 42-45 have been amended and claims 4, 17 and 32 have been canceled. No new claims have been added to the application. Accordingly, claims 1-3, 5-16, 18-31 and 33-45 are pending in the application. No new matter has been added.

In the prior Office Action, the Examiner rejected claims 1-4, 8-17, 21-27, 29, 30-32, 36-42, 44 and 45 under 35 U.S.C. §102(b) as being anticipated by Acitelli et al., U.S. Pat. 4,540,595. In view of the amendments made to the claims BY this amendment, and for the reasons set forth below, applicant respectfully requests reconsideration of the claim rejections under 35 U.S.C. §102(b).

Acitelli et al. discloses an ink that fluoresces in the near infrared portion of the electromagnetic spectrum. The fluorescing material is a phenoxazine dye. A phenoxazine dye is an organic compound and not an inorganic pigment.

In Fig. 4, Acitelli et al. shows the ink containing the phenoxazine dye applied in the form of a marking 35 on the back of a bank check 29. As noted by the Examiner, there are other markings on the bank check 29 including a handwritten endorsement 30, a rubber stamp and filled-in credit check block 31 and rubber stamp endorsements 32, 33 and 34 (see Fig. 4 and col. 4, lines 42). The marking 35 containing the phenoxazine dye and the other marks 30-34 on the back of the bank check 29 are all visible in the electromagnetic portion of the spectrum. Each is shown in Fig. 4. Applicant notes that marking 35 is not concealed from view in the visible portion of the electromagnetic spectrum by any of the other indicia added to the rear of the bank check 29. It is shown as an "intelligible bar code" (see col. 4, lines 45-46).

Claim 1 of the present application has been amended to more clearly distinguish the invention disclosed in Acitelli et al. Claim 1 of the present application now specifies that the marking material used to form the mark comprises an infrared reflective inorganic pigment. As noted, Acitelli et al. teaches the formation of a mark using of fluorescing organic dye. Furthermore, Acitellii et al. expressly prohibits the inclusion of any other pigments (see col. 1, line 67 to col. 2, line2):

The dye alone is relied on for visible color since the inclusion of supplementary pigments in the ink vehicle would interfere with the desired light transmission.

Thus, the amendment to claim 1 that now requires that the marking material comprises an infrared reflective inorganic pigment should be deemed sufficient to overcome the prior rejection under 35 U.S.C. §102(b) based on Acitelli et al. But applicant has made additional distinguishing amendments.

Claim 1 of the present application has also been amended to specify that the cover coating material comprises an inorganic pigment that is different than the infrared reflective inorganic pigment in the marking material, and that the cover coat formed from the cover coating material is substantially opaque in the visible portion of the electromagnetic spectrum such that it conceals the mark covered by the cover coat in the visible portion of the electromagnetic spectrum. This feature of applicants' invention is also clearly not taught or suggested by Acitelli et al. Acitelli et al. does not teach the use of any inorganic pigments in any of the markings formed on the bank check 29 (thus any conclusion that inorganic pigments are present in such inks is purely speculative). Furthermore, the mark 35 formed in Acitelli et al. is not concealed by a cover coat that is substantially opaque in the visible portion of the electromagnetic spectrum (the mark 35 is shown on the back of the bank check 29 in Fig. 4).

Claims 2, 3 and 8-13 depend from claim 1 and are thus patentable over Acitelli et al. for the same reasons that claim 1 is patentable over Acitelli et al. Claim 4 has been canceled, thereby rendering the prior rejection thereof moot.

The same amendments made to claim 1 to further distinguish Acitelli et al. have also been made to independent claim 14. Furthermore, applicant notes that claim 14 requires the presence of a contrast mark proximal to the mark, and the presence of a cover coat that appears substantially opaque in the visible portion of the electromagnetic spectrum and which conceals both the mark and the contrast mark covered by the cover coat in the visible portion of the electromagnetic spectrum. Acitelli et al. does not disclose any subject matter that would meet these limitations. Accordingly, claim 14 is clearly not anticipated by Acitelli et al.

Claims 15, 16 and 18-27 depend from claim 14 and are thus patentable over Acitelli et al. for the same reasons that claim 14 is patentable over Acitelli et al. Claim 17 has been canceled, thereby rendering the prior rejection thereof moot.

The same amendments made to claim 1 to further distinguish Acitelli et al. have also been made to independent claim 29. Furthermore, applicant notes that claim 29 requires the presence of a masking mark proximal to the mark, and the presence of a cover coat that appears substantially opaque in the visible portion of the electromagnetic spectrum and which conceals both the mark and the masking mark covered by the cover coat in the visible portion of the electromagnetic spectrum. Acitelli et al. does not disclose any subject matter that would meet these limitations. Accordingly, claim 29 is clearly not anticipated by Acitelli et al.

Claims 30, 31 and 36-42 depend from claim 29 and are thus patentable over Acitelli et al. for the same reasons that claim 29 is patentable over Acitelli et al. Claim 32 has been canceled, thereby rendering the prior rejection thereof moot.

The same amendments made to claim 1 to further distinguish Acitelli et al. have also been made to independent claims 44 and 45. Claims 44 and 45 are thus not anticipated by Acitelli et al. Reconsideration is respectfully requested.

Also in the prior Office Action, the Examiner rejected claims 5-7, 18-20, 28, 33-35 and 43 as being unpatentable over Acitelli et al. in view of Swiler, U.S. Pat. 6,485,557. The teachings of Acitelli et al. have been discussed above. Swiler discloses inorganic pigments made from manganese vanadium oxides. The Examiner reasons that one having ordinary skill in the art would have found it obvious to incorporate the inorganic pigments disclosed in Swiler in the inks according to Acitelli et al. This reasoning contradicts the teachings of Acitelli et al., which state at col. 1, line 67, to col. 2, line 2, that:

The dye alone is relied on for visible color since the inclusion of supplementary pigments in the ink vehicle would interfere with the desired light transmission.

There is absolutely nothing in Swiler that would lead one having ordinary skill in the art to modify Acitelli et al. Furthermore, Acitelli et al., if modified as suggested by

Application No. 10/597781
Amendment dated February 22, 2010
Reply to Office action of January 5, 2010

the Examiner, would not meet the limitations of claims 5-7, 18-20, 28, 33-35 and 43 because Acitelli et al. does not teach forming a cover coat that covers the mark, a contrast mark and/or a masking mark which is substantially opaque in the visible portion of the electromagnetic spectrum as claimed. Accordingly, the claim rejections under 35 U.S.C. §103(a) cannot be maintained.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge the same to Deposit Account No. 06-0625, Order No. FER-15400.001.001.

Respectfully submitted,

RANKIN, HILL & CLARK LLP

By: /Randolph E. Digges, III/

Randolph E. Digges, III

Reg. No. 40590

23755 Lorain Road, Suite 200
North Olmsted, OH 44070
TEL: (216) 566-9700
FAX: (216) 566-9711
docketing@rankinhill.com